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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91281307
Party	Defendant Tabacalera Palma, Ltd.
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Date	07/24/2023
Attachments	Notice regarding motion to compel.pdf(588695 bytes )

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

J.C. Newman Cigar Company

Opposer,

v.

Tabacalera Palma, Ltd.

Opposition No. 91281307  
Opposition to Serial No. 88866282  
Cancellation of Registration No. 5998883

Applicant.

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**NOTICE REGARDING MOTION TO COMPEL (D.E. 9)**

Applicant, Tabacalera Palma, Ltd. (“Tabacalera Palma” or “Applicant”), by and through undersigned counsel, hereby provides the following notice regarding the dispute described in its Motion to Compel (D.E. 9) as follows:

On July 11, 2023, and after Applicant moved to compel, Opposer served amended responses to interrogatories and requests for admissions. Those amended discovery responses resolve the dispute with respect to Applicant’s Interrogatories and First Set of Requests for Admissions.

Opposer also served documents Bates stamped JNC0000001-257 and confirmed that is has not withheld any documents based on privilege. However, Opposer indicated that it stands on its objections to Request for Production Nos. 12 and 22-26. The dispute with respect to Request for Production Nos. 12 and 22-26 remains a live controversy that requires Board intervention. The requests at issue and Opposer’s responses are reproduced below for the convenience of the Board.

12. Documents, if any, to show the purported acquired distinctiveness or secondary meaning of Newman's "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883.

**RESPONSE:** Opposer objects to Request No. 12 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

22. Documents sufficient to show the geographic place of origin of the tobacco used in Newman's cigars bearing the "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883.

**RESPONSE:** Opposer objects to Request No. 22 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

23. Documents sufficient to show the geographic place of origin of the boxes in which Newman's cigars bearing the "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883 are packaged and sold.

**RESPONSE:** Opposer objects to Request No. 23 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

24. Documents sufficient to show the geographic place of origin of the cigar rings used on Newman's cigars bearing the "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883.

**RESPONSE:** Opposer objects to Request No. 24 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

25. Documents sufficient to show the geographic location of the rolling facilities used for Newman's cigars bearing the "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883.

**RESPONSE:** Opposer objects to Request No. 25 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

26. Documents sufficient to show the geographic location of the curing facilities used for the tobacco in Newman's cigars bearing the "THE AMERICAN" trademark that is the subject of United States Trademark Registration No. 5998883.

**RESPONSE:** Opposer objects to Request No. 26 on the grounds that it asks for documents that are irrelevant to any issue in this opposition proceeding.

Applicant's position with respect to these requests is that, with respect to Request No. 12, Opposer made the Request relevant in its pleadings when Opposer specifically pled that "[i]f Applicant's Mark is allowed to register, it will impact [JC Newman's] ability to protect and enforce its own THE AMERICAN mark for cigars." See D.E. 1, ¶24; see also Fed.R.Civ.P. 26(b)(1) ("Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense . . . Information within this scope of discovery need not be admissible in evidence to be discoverable."); TBMP §402.01 ("A party may take discovery as to matters that are relevant to its claims and defenses (i.e., those specifically raised in the pleadings)"); Mack Trucks, Inc. v. Monroe Auto Equipment Co., 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition); and The Phillies v. Philadelphia Consolidated Holding Corp., 107 USPQ2d 2149, 2153 (TTAB 2013) (scope of permissible discovery would have been proportionately narrower if opposer had pleaded only the most relevant marks and clearly and specifically identified the goods and services relevant to this proceeding). Furthermore, and given the broad scope of Rule 26(b)(1), the request is relevant to Applicant's counterclaim based on section 2(d). Specifically, the ability of Opposer's "THE AMERICAN" trademark to function as a trademark is relevant to likelihood of confusion.

With respect to Requests 22-26, those requests are appropriate given the broad scope of discovery, including the liberal standard used to define relevance in discovery. See Off. Depot, Inc. v. Elementum Ltd., No. 9:19-CV-81305, at \*4 (S.D. Fla. Sept. 14, 2020)(“It is well established that the courts must employ a liberal standard in keeping with the purpose of the discovery rules.”); In re: Takata Airbag Prod. Liab. Litig., No. 14-24009-CV, 2016 WL 1460143, at \*2 (S.D. Fla. Mar. 1, 2016) (quoting Chief Justice John Roberts, 2015 Year-End Report on the Federal Judiciary 6 (2015)). Specifically, Opposer’s use of “AMERICAN” in connection with competing goods is or may be relevant to the meaning of the term “American” as used in the relevant industry and to consumers of the parties’ respective goods. In addition, the information sought could provide the basis for an alternative counterclaim (i.e., that if Applicant’s “AMERICAN STOGIES” mark is deceptively geographically misdescriptive, so is Opposer’s “THE AMERICAN” mark). See TBMP §402.01 (“A party may take discovery as to matters that are relevant to its claims and defenses (i.e., those specifically raised in the pleadings), and such discovery may serve as the basis for an additional claim, defense, or counterclaim.”).

Dated: July 24, 2023

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing has been served on:

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by email on July 24, 2023

By: s/GUSTAVO SARDIÑA  
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